

REMARKS

In the Office Action, claims 1 - 92 were noted as pending in the application, and all claims were rejected. By this amendment, no claims have been added, canceled, or amended. Thus, claims 1 - 92 are pending in the application. The rejections of the Office Action are traversed below.

Objection to the Specification

In item 6, on page 4 of the Office Action, it is noted that the request to add two new paragraphs relating to new Figures 7A and 7B should have been added at page 3, line 22 of the specification. The Applicants agree with the Examiner's observation and appreciate the Examiner making this correction.

Rejection of Claims 1 - 92 under 35 USC §103

In item 10, on pages 5 - 32 of the Office Action, claims 1 - 92 were rejected under 35 USC § 103 as being unpatentable over "Energy Design Tools," Murray Milne, published by the UCLA School of Arts and Architecture (printed from the Internet on November 30, 2004) ("Milne1"), in view of "Recent Papers," published by the UCLA School of Arts and Architecture (printed from the Internet on December 1, 2004) ("Recent Papers"); "Designing a sustainable library for Oak Park: Modeling air pollution and energy performance," abstract only, M. Milne (1997) ("Milne2"); "Building Energy Design Tool That Draws Pictures of Thermal Performance," abstract only, Murray Milne (1984) ("Milne3"); "An internet tool for designing energy efficient homes," abstract only, M. Milne et al. (1999) ("Milne4"); "A Drag-and-Drop Energy Design Tool," Murray Milne et al. (2001) ("Milne5"); "An Interactive Graphics Environment for Architectural Energy Simulation," Jon H. Pittman and Donald P. Greenberg (July, 1982) ("Pittman"); and "A computer program for calculating energy consumption in residential buildings," abstract only, N. Grewal (1988) ("Grewal"). This rejection is respectfully traversed.

As a threshold matter, the Office Action appears to be attempting to reject the claims as being obvious in view of three computer software packages, namely SOLAR-5, REED, and ENERGY. However, a rejection under 35 USC §103 requires prior published disclosure of each of the non-obvious features recited in the claims. MPEP §§706.02(a), 706.02(j). Further, under 35 USC §103, a claim can be rejected under a combination of published

AMENDMENTS TO THE FIGURES:

The Applicants acknowledge the objections raised in item 2, on pages 2 - 3 of the Office Action, and are preparing replacement Figures 1, 3, 4A, and 5A for filing with the U.S. Patent and Trademark Office.

references, but only if there is a motivation or suggestion for combining the references such that the claimed features are rendered obvious by the combination. MPEP §706.02(j). Accordingly, the Applicants presume the rejection of claims 1 - 92 under 35 USC §103 in the Office Action are in view of the eight references presented in item 10, on page 5 of the Office Action.

The Applicants note that the rejection of the Office Action fails to cite to Recent Papers, Milne2, or Milne3 in its various citations of support for claimed features allegedly found in the eight publications being relied upon under 35 USC §103 to reject claims 1 - 92, contrary to the requirements of 37 CFR §1.104(c)(2), MPEP §706.02(j). Accordingly, the Applicants respectfully request the Examiner to either cite to the specific portions of these references that are being relied upon to reject the features of particular claims or to drop the references from the rejection.

The present application was filed February 21, 2001, and any references being relied upon under 35 USC §103 must have a publication date prior to February 21, 2001. MPEP §706.02(a). A printout from an Internet web site is prior art only to the extent the printout includes a date the document was published on the site or a retrieval date for the document. MPEP §2128.01. A reference to an earlier date, such as the release of SOLAR 5.7 in June, 2000 in Milne1, does not comprise a publication date. Milne1 contains no publication date and was printed from its Internet site on November 30, 2004. Recent Papers also contains no publication date, and this reference was printed from its Internet Web site on December 1, 2004. Further, Recent Papers is little more than a listing of various articles relating to energy design considerations, with no disclosure of the content of the articles, much less a disclosure of any of the features recited in claims 1 - 92 herein. Therefore, neither Milne1 nor Recent Papers qualify as prior art under 35 USC §103, and the Applicants respectfully request the removal of these two references as a basis for the rejection of claims 1 - 92.

Milne5 shows a publication date of 2001 on this reference. However, Recent Papers lists this article as being published April, 2001. Therefore, Milne5 also fails to qualify as prior art under 35 USC §103, and the Applicants respectfully request the removal of this reference as a basis for the rejection of claims 1 - 92.

Finally, the Applicants respectfully note the publication date for Grewal is 1988, not 1998.

The Claimed Invention is Patentably Distinguishable Over the Cited Documents

The Applicants' claimed invention is directed to a computer-implemented system and method of selecting items that meet a given criteria when included in a project. In particular, and reciting relevant portions of independent claim 1, exemplary embodiments of Applicants' system for selecting a set of project items include the steps of:

- inputting project information, including project criteria;
- determining, with a computer, sets of items based on the project information that meet the criteria;
- calculating for each set of items a set value;
- selecting a set of items based on the calculated set values; and
- displaying to a user the selected set of items that meet the project criteria.

The Office Action cites to Milne5 as allegedly disclosing many of the recited features of independent claims 1, 33, 44, 45, 66, and 71. However, as noted above, Milne5 is not valid prior art. Further, the Office Action fails to meet all of the recited features of these independent claims, contrary to the requirements of MPEP §706.02(j). For example, the Office Action fails to explain which reference teaches the recited feature of “determining, with a computer, sets of items based on the project information that meet the criteria.” Nor does the Office Action address the recited feature of “calculating for each set of items a set value.” The Office Action cites to Milne5 as displaying a design, but the independent claims, such as claims 1 and 33, recite “displaying to a user the selected set of items that meet the project criteria.” The Office Action admits that Milne5 fails to disclose selecting a set of items based on the calculated set values. The Applicants respectfully note that if Milne5 does not disclose selection a set of items, then Milne5 cannot disclose displaying such a selected set of items, as also recited in claims 1 and 33.

The Office Action asserts, without support, that it is old and well known that the design of buildings includes variations of design parameters in an effort to select the best design. Not only do the Applicants agree with this statement, they have said as much in the background of the specification. The Office Action further asserts, without support, that it is old and well known that engineering involves the knowledge of mathematical and natural sciences and further employs known techniques to understand the design and construction of buildings. The Office Action further asserts, again without support, that it is old and well

known to use cost engineering and value engineering to ensure a project will achieve its design goals in a cost-effective matter. However, since the present claims do not recite use of mathematical and natural sciences and because the claims do not recite cost engineering or value engineering, whether any of these elements are indeed old and well known are immaterial as regards the non-obviousness of the present claims.

The Office Action continues by asserting that it would have been obvious to modify the SOLAR-5 system to include the selection of a set of items that meet targeted goals. However, the Office Action fails to cite to any suggestion or motivation in any of the articles discussing SOLAR-5 promoting such a modification of the SOLAR-5 system. The reasons none of the articles provide such a suggestion or motivation is that SOLAR-5 is not directed toward a system and method of selecting items for a project that satisfy a criteria, as claimed herein. Instead, SOLAR-5 is directed toward an energy results simulation tool that is limited to plotting energy performance, given a specific set of design components. See Milne1, Milne2, and Milne3 (even though Milne1 is not prior art).

The Office Action further cites to Pittman as a discussion of the ENERGY system and an assertion that the ENERGY system enables the selection of building components that meet the project criteria. However, Pittman discloses another simulation system which performs an building energy analysis after an architect has input all the design information into the ENERGY system or the databases utilized by the ENERGY system (Pittman at page 234, col. 1, paragraph 4; page 235, column 1, paragraphs 1 - 2; page 237, column 1, paragraph 2). Instead of automatically selecting a set of items that satisfy a set of values, Pittman clearly discloses that ENERGY is limited to graphical displays of energy consumption and losses based on predetermined building inputs (page 233, col. 2, paragraph 2; page 239, column 1, paragraphs 1 and 4). It is the architect, not the ENERGY system, that makes design choices after viewing the graphical output from ENERGY (page 239, column 1, paragraph 4; page 240, column 1, paragraph 1).

While teachings of several documents may be combined to render a claimed invention obvious, there must be a motivation or suggestion in the documents relied upon to make the specific combination. The Applicants respectfully assert that no suggestion or motivation exists in any of the SOLAR-5 or ENERGY documents to combine the two simulation systems -- nor has the Office Action attempted to cite to any of the references to support such a combination. Instead, the Office Action merely makes the unsupported assertion,

contrary to the requirements of MPEP §706.02(j), that such a combination would have been obvious “to store and share project information.”

Independent claims 44, 45, 66, and 71 further recite the feature of calculating the cost of the set of items that meet project criteria to determine a lowest cost set. None of the valid references disclose such a feature -- nor does the Office Action cite to any of the references as disclosing or even suggesting such a feature.

For the reasons discussed above, independent claims 1, 33, 44, 45, 66, and 71 are believed to be patentably distinguishable over cited documents, either taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claims 1, 33, 44, 45, 66, and 71 be withdrawn.

Claims 2, 6, 13-14, and 30 depend from claim 1 and include all the features of that claim plus additional features. Therefore, for at least the reasons set forth above with respect to claim 1, it is submitted that claims 2, 6, 13-14, and 30 patentably distinguish over the cited documents, either taken alone or in any combination; and withdrawal of the rejection of claims 2, 6, 13-14, and 30 is respectfully requested.

Claims 34, 42, and 43 depend from claim 33 and include all the features of that claim plus additional features. Therefore, for at least the reasons set forth above with respect to claim 33, it is submitted that claims 34, 42, and 43 patentably distinguish over the cited documents, either taken alone or in any combination; and withdrawal of the rejection of claims 34, 42, and 43 is respectfully requested.

Claims 58, 61, and 90 depend from claim 45 and include all the features of that claim plus additional features. Therefore, for at least the reasons set forth above with respect to claim 45, it is submitted that claims 58, 61, and 90 patentably distinguish over the cited documents, either taken alone or in any combination; and withdrawal of the rejection of claims 58, 61, and 90 is respectfully requested.

Claims 77 and 78 depend from claim 71 and include all the features of that claim plus additional features. Therefore, for at least the reasons set forth above with respect to claim 71, it is submitted that claims 77 and 78 patentably distinguish over the cited documents, either taken alone or in any combination; and withdrawal of the rejection of claims 77 and 78 is respectfully requested.

Claims 3 - 5, 7, 11, 12, 15 - 26, 37 - 39, 48 - 51, 53, 56, 60, 69, 70, 73 - 75, 79 - 82, 84, 85, and 92 have been rejected in view, at least in part, of Milne5. However, as discussed

above, Milne5 is not prior art to this application. Therefore, withdrawal of the rejection of claims 3 - 5, 7, 11, 12, 15 - 26, 37 - 39, 48 - 51, 53, 56, 60, 69, 70, 73 - 75, 79 - 82, 84, 85, and 92 is respectfully requested.

Claims 8, 9, 27 - 29, 32, 34, 35, 47, 55, 59, 62 - 65, 68, and 86 - 89 have been rejected under the unsupported assertion that the features recited in these claims are old and well known and that it would have been obvious to incorporate them into the SOLAR-5 system. The Applicants request that the Examiner cite a reference supporting each of the assertions of the features recited in these claims as being old and well known, in accordance with MPEP §2144.03.

Claims 57 and 83 have been rejected under the unsupported assertion that SOLAR-5 discloses the features recited in these claims. Claim 57, for example, recites displaying the total amount of each type of insulation required in building the structure. Claim 83 further recites determining sets of insulation that may be used in constructing the structure in compliance with an energy baseline level. None of the references describing the SOLAR-5 system disclose such features -- nor has the Office Action cited to any of the references for support for such features, contrary to the requirements of MPEP §706.02(j). Therefore, withdrawal of the rejection of claims 57 and 83 is respectfully requested.

Claims 10, 36, 40, 41, 46, 52, 54, 55, 67, 72, and 76 have been rejected in view of the teachings of the Pittman and Grewal references. Claims 10, 36, 40, 41, 52, 54, 55, 67, 72, and 76 depend variously from independent claims 1, 33, 45, 66, and 71 and include all the features of those claims plus additional features. As discussed above, the ENERGY system disclosed in Pittman and Grewal is a building energy analysis system which graphically displays the energy performance of a building based on predetermined design parameters. Neither Pittman nor Grewal disclose determining sets of items based on project information that meet a criteria, selecting a set of items based on a calculated set of values, or calculating the cost of sets of items to determine the lowest cost, as recited in the independent claims. Therefore, for at least the reasons set forth above with respect to claims 1, 33, 45, 66, and 71, it is submitted that claims 10, 36, 40, 41, 52, 54, 55, 67, 72, and 76 patentably distinguish over the Pittman and Grewal, and withdrawal of the rejection of claims 10, 36, 40, 41, 52, 54, 55, 67, 72, and 76 is respectfully requested.

The Applicants note that the Office Action has presented two different bases for rejecting claims 34 and 55. On pages 25 and 16, respectively, claims 34 and 55 are rejected

under the unsupported assertion that the features recited in these claims are old and well know. However, on pages 6 and 26, respectively, claims 34 and 55 are rejected on the bases of allegedly prior art. The Applicants respectively request the rejection of claims 34 and 55 be clarified.

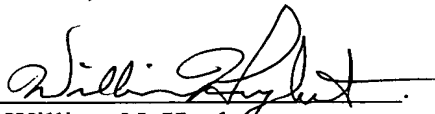
The Applicants also note that claims 31 and 91 have been rejected in the Office Action under 35 USC §103, but the Office Action has failed to discuss the features of these claims in its rejection, nor has the Office Action cited to any art that allegedly discloses the features recited in these claims, contrary to the provisions of MPEP §706.02(j). Accordingly, the Applicants respectfully request withdrawal of the rejections of claims 31 and 91.

Summary

It is submitted that none of the documents, either taken alone or in combination, teach the claimed invention. Thus, claims 1 - 92 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,

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Date: May 17, 2005